

## REMARKS

Claims 17-19, 21- 33, 35-46 and 72-74 were pending.

Claim 45 is cancelled.

Claims 17-19, 21-33, 35-44, 46 and 72-74 are pending.

### **Double Patenting Rejections**

Application Serial No. 10/508,349

The Applicants enclose a terminal disclaimer to overcome the provisional double patenting rejection based on pending application number 10/508,349.

US 6,545,079

As to the above granted patent, the Applicants believe the present claims to be unobvious in light of claims 1-13 of US 6,545,079.

The Examiner states that although the compositions are taught by the reference for other purposes, the compositions produced would be identical, and are made using the same method as presently claimed.

Obviousness double patenting may not use the disclosure of the reference cited, only the claims are applicable.

Double patenting is not concerned with what one skilled in the art would be aware from reading the claims but with what inventions the claims define.

Claims of US '079 are directed to a different purpose. In other words, the method is directed to forming a transparent coating on cellulose. The composition requires a slurry of water, at least one wax-free, polymer dispersion, talc particles of high purity, anti-foam agent and sodium hydroxide.

The present invention is directed to a method for making a size composition. Two separate fractions must be made identified as a pigment fraction and a water soluble size fraction.

US '079 claims disclose a pigment and a wax-free polymer dispersion but says nothing about a water-soluble component.

The present claims are concerned with providing a method for making a size composition which must contain a principal water-soluble component and a binder pigment fraction.

Thus the present claims define a different invention (different methods and different compositions) from that defined in US '079 and as such are unobvious in light of US '079.

### **35 USC 103(a)**

Claims 17-19, 21-44, 46, 72 and 73 are rejected under 35 USC 103(a) as being unpatentable over Aho et al, WO 98/54410.

As to the calculations provided by the Applicants in the last Office Action, the Examiner is correct. The basis for the ratio of pigment fraction to size fraction is calculated as dry matter. Nevertheless,

Examiner refers specifically to example 1 in Aho.

Reconsidering the weight ratios of pigment fraction to sizing fraction (water-soluble) in example 1 of Aho based on dry matter:

8.2 g of latex (sodium polyacrylate)  
16.2 g of sodium carboxymethyl cellulose-water soluble component  
2.4 g sodium hydroxide  
2700 g talc

Considering the total solids, a ratio of 2708.2:16.2 is calculated or **99.4 :0.6** which is very far outside the present claim limitation. Thus the Applicants do not understand the Examiner's statement that "this ratio of 90/10 is shown." See page 6 of Office Action of June 8, 2006.

Examiner also refers additionally to example 2 which he alleges is more in line with the ratio recited. However, if the Applicants take into account example 2, one finds the ratio is even more far outside the present claim limitation.

It is not clear whether the latex of example 2 is combined with pigment dispersion in example 1 as example 2 reads that the talc, either as a powder or granulated is slurried in a polymer latex. If the latex was combined directly with the powdered or granulated talc, then example 2 shows no water-soluble component at all.

If example 1 is combined with example 2, the ratio of pigment fraction to water soluble fraction the ratio is calculated below:

1700 g polymer latex at 50% solids = 850 g

1700 g of talc dispersion from example 1. This dispersion includes sodium carboxymethyl cellulose. However, not all the pigment dispersion is used. Only 1700 g is used. Thus one can assume that because only about 63% ( $1700/2700 * 100$ ) of the talc dispersion formed in example 1 is used that only about 63% of the sodium carboxymethyl cellulose ( $.63 * 16.2 = 10.2$  g) is present in example 2

pigment fraction 850 + 1700 = 2550 g

carboxymethyl cellulose 10.2 g

Thus the ratio for example 2 is **250:1**.

The Examiner alleges that the ratio is within "the range that a skilled artisan would know",

The Applicants submit that there is no suggestion in Aho to arrive at an optimal range of a pigment fraction and a water-soluble **principal** fraction when the examples show only very minor water soluble components far outside the ratios claimed.

To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to **why** the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The Examiner has simply stated that the ratio is within "the range that a skilled artisan would know".

The Applicants believe this to not be the case.

Claim 45 is rejected under 35 USC 103(a) as being unpatentable over Aho et al, WO 98/54,410, as applied to claim 17 above and further in view of Niinikoski et al US 6,753,377.

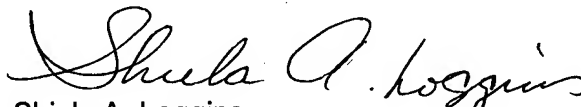
Claim 45 is cancelled making the rejection moot.

Reconsideration and withdrawal of the rejection of claims 17-19, 21-44, 46 and 72-74 is respectfully solicited in light of the remarks and amendments *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 17-19, 21-44, 46 and 72-74 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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